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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,711	07/02/2001	Keng Kit Yeo	PHN17.710	8614

7590 03/10/2003

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[REDACTED] EXAMINER

NGUYEN, KIMBERLY T

ART UNIT	PAPER NUMBER
1774	7

DATE MAILED: 03/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/869,711	YEO, KENG KIT	
	Examiner	Art Unit	
	Kimberly T. Nguyen	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 December 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4,6-10,12,13 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4,6-10,12,13 and 24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>S</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This action is in response to the amendment submitted on December 26, 2002. It is acknowledged that claims 5, 11, and 14 are cancelled and new claim 15 is entered.

Claim Objections

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 15 been renumbered 24.

Claim 13 should also be amended to correct the dependency on renumbered claim 24 and not claim 15.

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Due to Applicants' amendments, the previous rejections of claims 1-2, 4, 8, and 12-14 under 35 USC 112, 2nd paragraph are withdrawn.

In column 2, it is still unclear what is meant by a region that is "integral" with surrounding regions.

The term "dull-translucent" in claim 4 is a relative term which renders the claim indefinite. The term "dull-translucent" is not defined by the claim, the specification does not

provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

Claims 1-4, 6-7, 9-10, and 12 are rejected under 35 U.S.C. 103(a) as being anticipated by Birmingham, Jr. et al., U.S. Pat. No. 5,789,466 as previously stated in the Office Action submitted on September 26, 2002.

As to the newly added limitation in claim 1 that the outer layer is “an element for a consumer product,” Birmingham shows a wire insulation or cable jacket, i.e. element for a consumer product.

As to the newly added limitation in claim 1 that “the outer layer is formed by a sol-gel process,” this limitation is a process step. Process limitations are given no patentable weight in matters of patentability of product inventions. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*.

As to the newly added limitation that the “at least a region forms a marking” in claim 1, Birmingham shows laser marked coating compositions in portions (column 3, lines 17-38).

As to the newly added limitation in claim 3 of “the different visual appearance,” Birmingham shows that the substrate is darkened to create a different visual appearance (column 1, liens 23-42).

As to the newly added limitation in claim 6 of “the outer layer further comprising at least one filler material” and in claim 7 of the “outer layer further comprising fluorided

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hydrocarbons,” Birmingham shows a laser marked coating composition comprising fluoropolymers, TiO₂ and/or carbon black filler (column 3, lines 39-49 and column 5, lines 21-39).

All other newly added amendments appear to be cosmetic.

Claims 1-6, 8, and 12 are rejected under 35 U.S.C. 103(a) as being anticipated by Robertson, U.S. Pat. No. 5,855,969 as previously stated in the Office Action submitted on September 26, 2002.

As to the newly added limitation in claim 1 that the outer layer is “an element for a consumer product,” Robertson shows a laser marked identification tag (Abstract), i.e. element for a consumer product.

As to the newly added limitation in claim 1 that “the outer layer is formed by a sol-gel process,” this limitation is a process step. Process limitations are given no patentable weight in matters of patentability of product inventions. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*.

As to the newly added limitation that the “at least a region forms a marking” in claim 1, Robertson shows laser marked zones (claim 1).

As to the newly added limitation in claim 3 of “the different visual appearance,” Robertson shows that the zones are blackened to create a different visual appearance (claim 1).

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As to the newly added limitation in claim 6 of “the outer layer further comprising at least one filler material,” Robertson shows a laser marked coating composition comprising TiO₂ and carbon black filler (column 5, lines 34-66).

As to the newly added limitation in claim 8 of “a further layer of polymer material,” Robertson shows coatings comprising the film-forming polymers with methyl and/or phenyl groups and pigments (column 5, lines 34-66).

All other newly added amendments appear to be cosmetic.

Claim 24 is rejected under 35 U.S.C. 103(a) as being anticipated by Robertson, U.S. Pat. No. 5,855,969.

Robertson is relied upon as above for claims 1 and 12. Robertson shows that the substrate (carrier) comprises metal (column 1, lines 1-59).

Claim Rejections - 35 USC § 103

Due to Applicants’ amendments, the previous rejection of claim 13 over Birmingham, Jr. et al., U.S. Pat. No. 5,789,466 is withdrawn and the following rejection is submitted.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson, U.S. Pat. No. 5,855,969.

Robertson is relied upon as above for claims 1, 12, and 24. Robertson shows that the substrate (carrier) comprises metal (column 1, lines 1-59).

Robertson does not show a separate anodized/oxidized coating which supports the outer coating as in instant claim 13. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make one or more coatings on the substrate since it

has been held that constructing a formerly integral structure into various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Response to Arguments

Applicants' argument filed December 26, 2002 have been fully considered but they are not persuasive.

On page 7, Applicants argue that Birmingham does not show the inorganic main chain as instant claimed, but that Birmingham shows an organic main chain. This is not persuasive because Birmingham shows in column 5, lines 21-39 that the main chain can be either organic or inorganic.

On page 8, Applicants argue that the instant invention is different from Robertson because the instant process involves forming by a sol-gel process. This argument is not persuasive because process limitations are given no patentable weight in matters of patentability of product inventions. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claims are unpatentable even though the prior art was made by a different process. *MPEP 2113*.

On page 8, Applicants argue that Robertson teaches that the surface should be highly reflective, and not dull-translucent as in instant claim 1. This argument is not persuasive because the term "dull-translucent" is a relative term which renders the claim indefinite. The term "dull-translucent" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably

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apprised of the scope of the invention. In addition, such levels of reflectivity or dull-translucence are optimizable and adjustable.

Conclusion

Applicant's AMENDMENT necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday, except on every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly T. Nguyen
Examiner
March 6, 2003

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

